

Claim List – Status and Support of Current Amendment Changes

Claim	Status	Type	Support for Current Changes
1	Pending	Method	There are no changes in this amendment.
2	Pending	Method	There are no changes in this amendment.
3	Pending	Method	There are no changes in this amendment.
4	Pending	Method	There are no changes in this amendment.
5	Pending	Method	There are no changes in this amendment.
6	Pending	Method	There are no changes in this amendment.
7	Pending	Method	There are no changes in this amendment.
8	Pending	Method	There are no changes in this amendment.
9	Pending	Method	There are no changes in this amendment.
10	Pending	Method	There are no changes in this amendment.
11	Pending	Method	There are no changes in this amendment.
12	Pending	Method	There are no changes in this amendment.
13	Pending	Method	There are no changes in this amendment.
14	Cancelled	N/A	N/A
15	Pending	Method	There are no changes in this amendment.
16	Pending	Composition	There are no changes in this amendment.
17	Pending	Composition	There are no changes in this amendment.
18	Pending	Composition	There are no changes in this amendment.
19	Pending	Composition	There are no changes in this amendment.
20	Pending	Composition	There are no changes in this amendment.
21-38	Cancelled	N/A	N/A
39	Pending	Composition	There are no changes in this amendment.

Applicant's Responses to the Examiner's Rejections, Arguments and Objections

35 USC § 112, second paragraph

Applicant has canceled claim 21.

35 USC § 103(a) Rejection Responses

Eberhard in View of Williams and LoSasso – Applicant would like to elaborate on Applicant's previous argument to the Examiner.

Applicant would like to state to the Examiner that neither, Eberhard, Williams or LoSasso teach the "source of the problem" in the dewatering of a biological sludge from a thermophilic digestion process; nor do any of the citations "contain the same solution for a similar problem". Applicant would like to cite MPEP 2141.02, which states:

"[A] patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. This is part of the 'subject matter as a whole' which should always be considered in determining the obviousness of an invention under 35 U.S.C. § 103." *In re Spinnoble*, 405 F.2d 578, 585, 160 USPQ 237, 243 (CCPA 1969). However, "discovery of the cause of a problem ... does not always result in a patentable invention. . . . [A] different situation exists where the solution is obvious from prior art which contains the same solution for a similar problem." *In re Wiseman*, 596 F.2d 1019, 1022, 201 USPQ 658, 661 (CCPA 1979) (emphasis in original)." (Emphasis added)

As previously presented to the Examiner, Applicant discovered "the source of the problem" and taught such in the instant invention.

The above is while Dentel, e.g. Steven K. Dentel, *Evaluation of Dual Chemical Conditioning and Dewatering of Aerobically Digested Biosolids*, August 18, 1996, (previously cited in this proceeding as well as the combined re-exam/re-issue) teaches away from the use of an iron salt coagulant in combination with a flocculant to dewater biological sludge. Specifically, Dentel states on page 11 – 29 that:

"The use of ferric chloride or HDTMA (a quaternary salt) as a preconditioner can reduce the polymer requirement, but this is not a cost effective option at current prices for these additives."

This is while a second article by Dentel, *Evaluation of Dual Chemical Conditioning and Dewatering of Anaerobically Digested Biosolids*, June 1995, (previously cited in this proceeding as well as the combine re-exam/re-issue) concludes on page 9 that:

“As a rule of thumb, it appears that adding a proportion of one chemical’s optimum dosage reduces the requirement for the other by the same amount. If this rule were invariably true, it would always be most economical to use only one of the conditioning chemicals by itself. However, the CST results also indicated that sole use of ferric chloride or HDTMA (quaternary salt) did not provide adequate dewaterability even at the optimum dose...”

And, on page 11 that:

“The use of ferric chloride or HDTMA (a quaternary salt) as a preconditioner can reduce the polymer requirement, this is not a cost effective option at current prices for these additives.”

Therefore, at late as 1996, it was not known to be economical to “precondition” ANY biological sludge with an iron salt prior to use of a cationic polyacrylamide, much less to condition a thermophilic biological sludge with an iron or an aluminum salt prior to use of a cationic or an anionic polyacrylamide.

This above is most important in relation to the Lo Sasso citation. As previously presented to the Examiner, Lo Sasso does not teach the dewatering of thermophilic bio-solids, as does Applicant in the instant invention. Further, Lo Sasso teaches the use of a non-ionic polyacrylamide which is specifically not taught or claimed by Applicant. This is while at the time of the instant invention, those of ordinary skill in the art would have had available the Dentel reference, as previously presented to the Examiner and quoted above, which teaches NOT to use a salt of iron with a cationic polyacrylamide in the dewatering of bio-solids. Therefore, for one of ordinary skill in the art to have developed the instant invention and the instant claims from the citations referenced by the Examiner at the time of the instant invention, one of ordinary skill in the art would have had to: 1) apply Lo Sasso to the dewatering of thermophilic bio-solids, when there is no teaching in Lo Sasso in relation to thermophilic bio-solids, 2) ignore the use of a non-ionic polyacrylamide as is taught in Lo Sasso, 3) ignore the fact that cationic polyacrylamides alone are unsuccessful in the watering of thermophilic bio-solids, as described in the instant invention, and use a cationic polyacrylamide anyway, 4) ignore the teachings of Dentel and apply the use of an iron (or an aluminum salt) as a preconditioner to the thermophilic biological sludge prior to use of a cationic or an anionic polyacrylamide anyway, 5) apply all of the above in light of Eberhard, while Eberhard teaches the use of an enzyme and a chelant, all the while ignoring the use of an enzyme and a chelant as taught in Eberhard, while 6) replacing both the enzyme and the chelant in Eberhard with an iron or

an aluminum salt (again wherein Dentel teaches away while Lo Sasso requires a non-ionic polyacrylamide in a different application).

Applicant would like to present to the Examiner that such an irrational path is not a path for one of ordinary skill in the art, or quite frankly, for one of expert skill in the art; there are just too many irrational decisions which must be made with the cited references at the time of the instant invention without having the teaching and/or understanding of the source of the problem as taught in the instant invention. Most importantly, obviousness to try applies to teachings for the same purpose. At the time of the instant invention there was no obviousness to try pre-conditioning of ANY biological sludge with an iron or an aluminum salt prior to the use of a cationic polyacrylamide due to the teachings of Dentel. This is while due to the teachings of Lo Sasso, it would have been obvious to precondition "messophilic" bio-solids **with and only with the use of a non-ionic polyacrylamide**. This is while the instant invention **does not incorporate the use of a non-ionic polyacrylamide and the instant invention is for a different purpose, e.g. the dewatering of "thermophilic" bio-solids; and, it would have been obvious to one of ordinary skill in the art that the dewatering of thermophilic bio-solids is a "different purpose" than the dewatering of mesophilic bio-solids, as mesophilic bio-solids are traditionally dewatered with a cationic polyacrylamide, while as taught and demonstrated in the instant invention, thermophilic bio-solids are difficult at best to dewater with a cationic polyacrylamide. Therefore, and without question, to one of ordinary skill in the art, the dewatering of messophilic bio-solids and the dewatering of thermophilic bio-solids are different purposes. This is while Lo Sasso, Dentel and Wilson are different purposes than the instant invention, e.g. messophilic bio-solids while the instant invention is thermophilic bio-solids.** Then, in order to develop the instant invention, one of ordinary skill in the art would have to take the teachings of Lo Sasso for mesophiles and apply to thermophiles, again different purposes, while replacing the non-ionic polyacrylamide in Lo Sasso with the cationic polyacrylamide in Eberhard, which does teach the dewatering of thermophiles and is the same purpose of the instant invention, all the while ignoring the enzyme and chelant teachings in Eberhard, which is again the same purpose as the instant invention, and replace the same purpose teachings in Eberhard for the enzyme and chelant with different purpose teachings in Lo Sasso for an iron or an aluminum salt. Wow!

Given the requirements for and rather irrational decision making required of one of ordinary skill in the art at the time of the instant invention in order for one of ordinary skill in the art to develop

the instant invention, Applicant would like to suggest that the Examiner's citation combination, e.g. Eberhard, Wilson and Lo Sasso, is "hindsight reconstruction". Applicant would like to refer the Examiner to MPEP 2144.06 which states:

COMBINING EQUIVALENTS KNOWN FOR THE SAME PURPOSE

"It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... [T]he idea of combining them flows logically from their having been individually taught in the prior art." *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980) (citations omitted) (Claims to a process of preparing a spray-dried detergent by mixing together two conventional spray-dried detergents were held to be *prima facie* obvious.). See also *In re Crockett*, 279 F.2d 274, 126 USPQ 186 (CCPA 1960) (Claims directed to a method and material for treating cast iron using a mixture comprising calcium carbide and magnesium oxide were held unpatentable over prior art disclosures that the aforementioned components individually promote the formation of a nodular structure in cast iron.); and *Ex parte Quadranti*, 25 USPQ2d 1071 (Bd. Pat. App. & Inter. 1992) (mixture of two known herbicides held *prima facie* obvious). But see *In re Geiger*, 815 F.2d 686, 2 USPQ2d 1276 (Fed. Cir. 1987) ("Based upon the prior art and the fact that each of the three components of the composition used in the claimed method is conventionally employed in the art for treating cooling water systems, the board held that it would have been *prima facie* obvious, within the meaning of 35 U.S.C. 103, to employ these components in combination for their known functions and to optimize the amount of each additive.... Appellant argues... hindsight reconstruction or at best,... 'obvious to try'.... We agree with appellant.").

SUBSTITUTING EQUIVALENTS KNOWN FOR THE SAME PURPOSE

In order to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on applicant's disclosure or the mere fact that the components at issue are functional or mechanical equivalents. *In re Ruff*, 256 F.2d 590, 118 USPQ 340 (CCPA 1958) (The mere fact that components are claimed as members of a Markush group cannot be relied upon to establish the equivalency of these components. However, an applicant's expressed recognition of an art-recognized or obvious equivalent may be used to refute an argument that such equivalency does not exist.); *In re Scott*, 323 F.2d 1016, 139 USPQ 297 (CCPA 1963) (Claims were drawn to a hollow fiberglass shaft for archery and a process for the production thereof where the shaft differed from the prior art in the use of a paper tube as the core of the shaft as compared with the light wood or hardened foamed resin core of the prior art. The Board found the claimed invention would have been obvious, reasoning that the prior art foam core is the functional and mechanical equivalent of the claimed paper core. The court reversed, holding that components which are functionally or mechanically equivalent are not necessarily obvious in view of one another, and in this case, the use of a light wood or hardened foam resin core does not fairly suggest the use of a paper core.); *Smith v. Hayashi*, 209 USPQ 754 (Bd. of Pat. Inter. 1980) (The mere fact that phthalocyanine and selenium function as equivalent photoconductors in the claimed environment was not sufficient to establish that one would have been obvious over the other. However, there was evidence that both phthalocyanine and selenium were known photoconductors in the art of electrophotography. "This, in our view, presents strong evidence of obviousness in

substituting one for the other in an electrophotographic environment as a photoconductor." 209 USPQ at 759.).

An express suggestion to substitute one equivalent component or process for another is not necessary to render such substitution obvious. *In re Fout*, 675 F.2d 297, 213 USPQ 532 (CCPA 1982)."

Applicant would also like to present to the Examiner excerpts from the MPEP relating to teaching away, e.g. Dentel and Dentel in combination with Eberhard, Wilson and Lo Sasso. MPEP 2145 D states:

D. References Teach Away from the Invention or Render Prior Art Unsatisfactory for Intended Purpose

In addition to the material below, see **MPEP § 2141.02** (prior art must be considered in its entirety, including disclosures that teach away from the claims) and **MPEP § 2143.01** (proposed modification cannot render the prior art unsatisfactory for its intended purpose or change the principle of operation of a reference).

1. The Nature of the Teaching Is Highly Relevant

A prior art reference that "teaches away" from the claimed invention is a significant factor to be considered in determining obviousness; however, "the nature of the teaching is highly relevant and must be weighed in substance. A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." *In re Gurley*, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994) (Claims were directed to an epoxy resin based printed circuit material. A prior art reference disclosed a polyester-imide resin based printed circuit material, and taught that although epoxy resin based materials have acceptable stability and some degree of flexibility, they are inferior to polyester-imide resin based materials. The court held the claims would have been obvious over the prior art because the reference taught epoxy resin based material was useful for applicant's purpose, applicant did not distinguish the claimed epoxy from the prior art epoxy, and applicant asserted no discovery beyond what was known to the art.).

Furthermore, "the prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed...." *In re Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004). **(Emphasis added)**

2. References Cannot Be Combined Where Reference Teaches Away from Their Combination

It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983) (The claimed catalyst which contained both iron and an alkali metal was not suggested by the combination of a reference which taught the interchangeability of antimony and alkali metal with the same beneficial result, combined with a reference expressly excluding antimony from, and adding iron to, a catalyst.).

Specifically, none of the references cited individually or in combination teach the use of a cationic or an anionic polyacrylamide in combination with an iron or an aluminum salt to dewater a sludge, much less a thermophilic biological sludge, as is required in independent claim 1. Instant independent claim 1 states:

1. A method for dewatering thermophilic biological sludge, comprising:
 - a. adding a primary component to the thermophilic biological sludge;
said primary component comprising at least one of aluminum sulfate and ferric chloride; wherein
said primary component may also comprise a polymeric quaternary ammonium compound; and
 - b. adding a cationic or anionic polyacrylamide to the thermophilic biological sludge.

As a further demonstration to the Examiner that the dewatering of thermophilic bio-solids was not obvious at the time of invention of the instant invention, Applicant refers the Examiner to a document prepared by the US EPA. One of ordinary skill in the art would be a person with a degree in environmental science, or many years of on the job training plus state certification. At the time of the conception and reduction to practice of the claimed invention, one of ordinary skill in the art would have knowledge of an EPA publication:

TBS Pakasam, et al., *Effect of Recycling Thermophilic Sludge on the Activated Sludge Process*, EPA Project Summary 5, September 1990.

The EPA publication stated under the heading:

“Dewaterability

Capillary suction time (CST) measurements at various polymer dosages indicated that mesophilic sludge required a lower polymer dosage than did the thermophilic sludge (10 vs. 22.5 kg/dry tonne) to achieve the minimum CST that was possible. The thermophilic sludge, however, exhibited a higher floc strength than did the mesophilic sludge.

Pilot scale centrifugal studies confirmed that the thermophilic sludge requires highest polymer dosage than did the mesophilic sludge. At optimum polymer dosages, those studies also indicated that the mesophilic sludge approached 100% solids capture whereas the thermophilic solids approached a maximum of 96% capture. The lower solids capture with thermophilic sludge probably resulted from the higher concentration of fine particles in it than in the mesophilic sludge.”

The EPA Publication recommended that:

“Based on the lack of effect on sludge mass and the increase in digestion capacity required, the Torpsy process is not recommended for Chicago’s conventional rate activated sludge plants. Nor is thermophilic digestion as the terminal sludge digestion process recommended if the sludge is to be used at a site with nearby neighbors.”

Thus, one of ordinary skill in the art at the time of invention of the instant invention would further know that thermophilic bio-solids (sludge) were not easily dewatered while there was obviously a need at that time to easily dewater thermophilic bio-solids. If the instant invention were obvious as indicated by the Examiner in the combination of Eberhard, Wilson and Lo Sasso, certainly those of expert skill in the art, the US EPA, would have known and demonstrated such in Chicago. As those of expert skill in the art, the US EPA, were not aware of the instant invention at the time of invention of the instant invention, the instant invention could not have been obvious at the time of invention.

The Examiner states:

“Claims 2 and 3 specify more specifically than in claim 1 the chemical identity of the polyquaternary ammonium compound, but none of claims 1 – 5, 7 requires that the polyquaternary ammonium compound or aluminum sulfate be present. Claim 1 merely states that the primary component “**may also comprise**” the polyquaternary ammonium compound (emphasis added).”

Applicant would like to respectfully refer the Examiner to instant claim 1, wherein it is stated

1. A method for dewatering thermophilic biological sludge, comprising:
 - a. adding a primary component to the thermophilic biological sludge;
said primary component comprising at least one of aluminum sulfate and ferric chloride; wherein
said primary component may also comprise a polymeric quaternary ammonium compound; and
 - b. adding a cationic or anionic polyacrylamide to the thermophilic biological sludge.

(Emphasis added)

Therefore, by the claim limitations within instant independent claim 1, the claimed invention must comprise an aluminum salt or an iron salt. This is while the use of a polymeric quaternary ammonium compound is optional.

The Examiner states:

“Per claims 8-9, the concentration of a dewatering polymer relative to solids content in a dewatering operation was at the time the invention was made known to have an effect on the dewatering performance. Therefore, it would have been obvious to have varied and optimize this parameter for particular sludges.”

Applicant would like to respectfully quote MPEP Section 2143.03 which states, "If an independent claim is non-obvious under 35 U.S.C. 103, then any claim depending there from is non-obvious *In re Fine*, 837 F2d.1071, 5 USPQ 2d 1596, Fed. Cir. 1988." Therefore, Applicant herein respectfully requests an allowance of claims 8 – 9 as presented herein; as, the Examiner's argument has been traversed relating to independent claim 1 from which dependant claims 8 – 9 depend.

The Examiner states:

"Per claim 39/17, it was well known to mix[ed] primary sludge with digested sludge in such processes, so it would have been obvious to have done so using Eberhard's process as well. See or example, United States Patents: 4380496, 3613564, 3397139."

Applicant would like to respectfully quote MPEP Section 2143.03 which states, "If an independent claim is non-obvious under 35 U.S.C. 103, then any claim depending there from is non-obvious *In re Fine*, 837 F2d.1071, 5 USPQ 2d 1596, Fed. Cir. 1988." Therefore, Applicant herein respectfully requests an allowance of claim 39 as presented herein; as, the Examiner's argument has been traversed relating to independent claim 17 from which dependant claim 39 depends.

The Examiner states:

"USP 4193869 is directed to wastewater treatment. It teaches that organic polymers can be used with an inorganic coagulant such as ferric chloride and aluminum sulfate (alum) while USP 5500131 to Metz teaches that combinations of ferric chloride and aluminum sulfate flocculants can be used. It would have been obvious therefore to have used aluminum sulfate in place of ferric chloride, or to have used a combination of ferric chloride and aluminum sulfate in the Eberhard method as modified by Lo Sasso, as suggested by Metz or USP 4193869."

Applicant wishes to repeat the above argument relating to iron salts in combination with a cationic or anionic polyacrylamide in the dewatering of thermophilic bio-solids. Applicant also wishes to state to the Examiner that the same argument applies in relation to the Dentel reference which teaches away from the use of an iron salt as a preconditioner to a cationic polyacrylamide in the dewatering of biological sludge. Therefore, Dentel also teaches away from the use of an aluminum salt as a preconditioner to a cationic polyacrylamide in the dewatering of a biological sludge.

Secondary Consideration – Commercial Success Copying by Others

As a further indication of un-obviousness and as demonstrated in instant application example 9 (as well as examples 6 and 7 for a polyquaternary amine in combination with a polyacrylamide), Applicant demonstrated the instant invention and instant invention claims at the wastewater plant for College Station Texas. As evidenced in the attached declarations of

both Richard Haase and Audrey Haase, the instant invention and instant invention claims were copied in the operation of the dewatering of thermophilic biological sludge at the wastewater treatment plant for College Station Texas. This copying and commercial success by others further demonstrates unobviousness of the instant invention and the instant invention claims; as, if the instant invention or the instant invention claims had been obvious, the instant invention or the instant invention claims would have been in use prior to demonstration by Applicant. This is especially true since as demonstrated by the above US EPA document, there had been a need prior to the instant invention since at least 1990 to dewater thermophilic bio-solids. In further support of this argument, Applicant refers the Examiner to MPEP 716.01(a):

OBJECTIVE EVIDENCE MUST BE CONSIDERED WHEN TIMELY PRESENT

Affidavits or declarations>, when timely presented,< containing evidence of criticality or unexpected results, commercial success, long-felt but unsolved needs, failure of others, skepticism of experts, etc., must be considered by the examiner in determining the issue of obviousness of claims for patentability under **35 U.S.C. 103**. The Court of Appeals for the Federal Circuit stated in *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538, 218 USPQ 871, 879 (Fed. Cir. 1983) that "evidence rising out of the so-called 'secondary considerations' must always when present be considered en route to a determination of obviousness." Such evidence might give light to circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or unobviousness, such evidence may have relevancy. *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966); *In re Palmer*, 451 F.2d 1100, 172 USPQ 126 (CCPA 1971); *In re Fielder*, 471 F.2d 640, 176 USPQ 300 (CCPA 1973). The *Graham v. John Deere* pronouncements on the relevance of commercial success, etc. to a determination of obviousness were not negated in *Sakraida v. Ag Pro*, 425 U.S. 273, 189 USPQ 449 (1979) or *Anderson's-Black Rock Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 163 USPQ 673 (1969), where reliance was placed upon *A&P Tea Co. v. Supermarket Corp.*, 340 U.S. 147, 87 USPQ 303 (1950). See *Dann v. Johnston*, 425 U.S. 219, 226 n.4, 189 USPQ 257, 261 n. 4 (1976).

Examiners must consider comparative data in the specification which is intended to illustrate the claimed invention in reaching a conclusion with regard to the obviousness of the claims. *In re Margolis*, 785 F.2d 1029, 228 USPQ 940 (Fed. Cir. 1986). The lack of objective evidence of nonobviousness does not weigh in favor of obviousness. *Miles Labs. Inc. v. Shandon Inc.*, 997 F.2d 870, 878, 27 USPQ2d 1123, 1129 (Fed. Cir. 1993), *cert. denied*, 127 L. Ed. 232 (1994). However, where a *prima facie* case of obviousness is established, the failure to provide rebuttal evidence is dispositive.

As the attached declarations demonstrate a nexus between the instant claims and copying by others in College Station, Applicant refers the Examiner to MPEP 716.03:

I. NEXUS BETWEEN CLAIMED INVENTION AND EVIDENCE OF COMMERCIAL SUCCESS REQUIRED

An applicant who is asserting commercial success to support its contention of nonobviousness bears the burden of proof of establishing a nexus between the claimed invention and evidence of commercial success.

The Federal Circuit has acknowledged that applicant bears the burden of establishing nexus, stating:

In the *ex parte* process of examining a patent application, however, the PTO lacks the means or resources to gather evidence which supports or refutes the applicant's assertion that the sale constitute commercial success. *C.f. Ex parte Remark*, 15 USPQ2d 1498, 1503 (Bd. Pat. App. & Int. 1990)(evidentiary routine of shifting burdens in civil proceedings inappropriate in *ex parte* prosecution proceedings because examiner has no available means for adducing evidence). Consequently, the PTO must rely upon the applicant to provide hard evidence of commercial success.

In re Huang, 100 F.3d 135, 139-40, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996). See also *In re GPAC*, 57 F.3d 1573, 1580, 35 USPQ2d 1116, 1121 (Fed. Cir. 1995); *In re Paulsen*, 30 F.3d 1475, 1482, 31 USPQ2d 1671, 1676 (Fed. Cir. 1994) (Evidence of commercial success of articles not covered by the claims subject to the 35 U.S.C. 103 rejection was not probative of nonobviousness).

The term "nexus" designates a factually and legally sufficient connection between the evidence of commercial success and the claimed invention so that the evidence is of probative value in the determination of nonobviousness. *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 7 USPQ2d 1222 (Fed. Cir. 1988).

KSR International v. Teleflex, Inc. et al., No. 04-1350, 550 U.S. (2007)

Finally, Applicant refers the Examiner to recent U.S. Supreme Court Case Law, *KSR International v. Teleflex, Inc. et al., No. 04-1350, 550 U.S. (2007)*.

4. The Federal Circuit's perspective on the problem of hindsight is itself problematic. This Court cautioned in *Graham* against "read[ing] into the prior art the teachings of the invention in issue." 383 U.S. at 36. The Court did not perceive, however, any need for extraordinary showings of obviousness to avoid that danger. The Federal Circuit's rigid test underestimates the capacity of courts and the PTO to avoid the influence of hindsight. Retrospective analysis is not unique to patent law, but regularly arises in a wide variety of contexts, including the determination of the competency of counsel in criminal proceedings, see, e.g., *Rompilla v. Beard*, 125 S. Ct. 2456, 2462 (2005), reasonable use of force by police officers, see, e.g., *Graham v. Connor*, 490 U.S. 386, 396 (1989),

and probable cause, see, e.g., *Maryland v. Garrison*, 480 U.S. 79, 85 (1987). In those situations, as in *Graham*, the Court has consistently recognized that decisionmakers can avoid the improper influence of hindsight by maintaining conscious awareness of its potentially distorting influence in the decisionmaking process.¹⁰ Courts routinely find, for example, an absence of probable cause in cases in which the police in fact find substantial quantities of contraband in a search. There is no reason to think that courts in patent cases cannot be similarly discerning.

The “ultimate question” of patent validity under Section 103(a) is a question of law. *Graham*, 383 U.S. at 17. It rests on a legal judgment, informed by relevant facts, of whether the hypothetical person having ordinary skill in the art would have found the invention as a whole “obvious.” Section 103(a) itself identifies three “central factors relevant to any inquiry into obviousness” (*Johnston*, 425 U.S. at 226): the scope and content of the prior art, the differences between the prior art and the claims at issue, and the level of ordinary skill in the pertinent art. See *Graham*, 383 U.S. at 17. Other “secondary considerations”—including a long-felt and unfulfilled need for the invention, the prior failures of others, and the commercial success of the invention—may also provide “indicia” supporting the legal conclusion of “obviousness or nonobviousness,” *id.* at 17-18, 35-36, but those considerations will not render an obvious invention patentable. *Anderson’s-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 61 (1969) (citing *Great Atl. & Pac. Tea Co. v. Supermarket Equip. Corp.*, 340 U.S. 147, 153 (1950)).

As Applicant has respectfully traversed the Examiner’s 35 U.S.C. 103(a) rejections, Applicant respectfully requests an allowance of all of the claims pending and amended herein. Applicant specifically requests an allowance of claims 1 – 5, 7 – 9, 15, 16, 17, 18, 21/16, 21/17, 21/18, and 39/17, as amended herein.

Correction of Reissue Declaration filed 5/25/2001 is Required

Applicant has enclosed a corrected Reissue Declaration.

Supplemental Reissue Declaration Required

Applicant has enclosed a Supplemental Reissue Declaration.

CONCLUSION

Applicant respectfully requests entry of this response and amendment, along with favorable reconsideration of the pending claims. This amendment places the claims in a condition for allowance. There are no amendments to the claims, wherein one claim was canceled; therefore, no additional searching is required. Additionally, Applicant requests that in view of this fact, this response and amendment be entered, and after due consideration of the facts presented herein, the claims be allowed and a certificate be issued.

To facilitate the resolution of any issues or questions presented by this paper, Applicant respectfully requests that the Examiner directly contact the undersigned by phone to further the discussion, reconsideration and allowance of the claims.

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'R. Haase', written over a horizontal line.

Richard A. Haase, Pro Se' Applicant

Date: December 20, 2007

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